

United States Patent and Trademark Office OG Notices: 17 September 2002

Electronic Submission of Information Disclosure Statements

Summary: Information disclosure statements (IDS) may be electronically submitted to the United States Patent and Trademark Office (USPTO or Office) via the Office's Electronic Filing System (EFS). When making such an EFS submission of an IDS, paper copies of U.S. patents and U.S. patent application publications cited in the IDS will no longer have to be supplied by applicants. Thus, the Office is implementing a change which has been requested by many applicants and patent practitioners in order to eliminate the burden associated with the making and supplying of paper copies of U.S. patents and patent application publications.

Description of EFS Upgrade to Permit the Electronic Filing of an IDS

A new EFS software upgrade has added an IDS (submitted under the provisions of 37 CFR 1.97 and 1.98) as a sixth type of electronic submission that may be made via the Office's EFS. With the EFS software upgrade, an applicant will be able to electronically transmit an IDS with the filing of a new utility patent application, or as a subsequent filing. This EFS software upgrade will NOT be usable for third party information disclosure submissions under 37 CFR 1.99. The IDS submission via EFS is the only electronic substitute for a paper IDS submission contemplated. The upgrade is available as of May 28, 2002. The EFS has been available to the general public for limited electronic filing since October 2000. See Electronic Filing System Available to Public, 1240 OG 45, November 14, 2000. This EFS software is currently used for five types of electronic submissions: (1) for filing new utility and (2) provisional patent applications; (3) for submitting nucleotide and/or amino acid sequence listings; (4) for submitting copies of applications for pre-grant publication purposes with requests for voluntary publication, as amended publication, republication, early publication and redacted publication and (5) for submitting multiple assignment records. Applicants using EFS submit encrypted text and image files to the USPTO and receive an immediate "Acknowledgment Receipt" that summarizes their submission.

Information regarding EFS, its uses and its operation is available from the Office's Electronic Business Center (EBC), the e-commerce home (web site <http://www.USPTO.gov/ebc/>) for the USPTO with links to systems for doing business electronically with the Office. Two useful systems linked from the EBC are EFS, described above, and the Patent Application Information Retrieval (PAIR) system, providing data regarding the status of an application or of a patent to patent applicants and/or their designated representatives prior to publication, and to public users after the first publication date.

The EFS software upgrade affects only the submission and form authoring software component called ePAVE (Electronic Packaging And Validation Engine). This ePAVE software allows the user to enter data required for transmittal to the Office into forms that are predefined according to each of the six types of electronic EFS submissions and builds an extensible Markup Language (XML) document with tags that identify the content of each element of the submission. The ePAVE software also validates the XML document data and securely transmits the XML document to the USPTO. The software upgrade is available from the download page on the Electronic Business Center's web site (<http://www.uspto.gov/ebc/downloads.html>). The software upgrade may be installed by executing the file downloaded from the Electronic Business Center. In the event that the software cannot be downloaded, a CD containing the software can be obtained from the Patent Electronic Business Center by calling 703-305-3028.

Applicants will file an IDS via EFS by (1) entering the references' citation information in an electronic data entry form, equivalent to the paper PTO-1449 form; and (2) transmitting the electronic data entry form data to the Office. This electronic form allows only citations for U.S. patents and U.S. patent application publications. If any references to foreign patent documents or non-patent literature documents or unpublished U.S. applications are to be cited, then applicants will submit those citations on a separate, conventional paper PTO-1449 form (or revised form PTO/SB/08). A printed copy of each cited foreign patent document, non-patent literature document and unpublished U.S. application via mail, facsimile transmission, or hand delivery should accompany the conventional IDS form. Applicants will not send the Office copies of any U.S. patent or U.S. application publication documents cited on an electronic IDS form that is electronically transmitted to the Office via EFS.

The electronic IDS form may be included with a new patent application submission, or it may be submitted for previously filed patent applications. The ePAVE software upgrade provides an electronic data entry IDS form equivalent to a paper PTO-1449, Information Disclosure Statement form, in which citations for up to 50 U.S. patents and up to 50 U.S. patent application publications may be entered. Each citation requires the patent or application number, the name of the patentee or applicant, and the date of issue or publication. The filer may optionally add the kind code, and U.S. patent class and subclass code for each citation. The electronic IDS form contains preprinted

certification statements that allow the user to make one of the two certifications required under 37 CFR 1.97(e), regarding citation of the documents in a communication from a foreign patent Office and knowledge of the cited documents by individuals under 37 CFR 1.56(c), by clicking on the appropriate certification. The electronic IDS form also contains a free form text area to allow the user to include statements of relevance or other remarks with regard to the cited documents. The ePAVE upgrade validates the format of data entered into the electronic IDS form, and transmits the XML formatted IDS data from the electronic data entry form to the Office. The ePAVE upgrade validates the format of data entered into the electronic IDS form and provide the means to specify whether the electronic IDS form is to be linked to an accompanying new application filing or is being filed in a previously filed application, and transmits the XML formatted IDS data from the electronic data entry form to the Office.

The IDS may be submitted as part of a new utility EFS electronic application filing, or as a subsequent submission for a previously filed patent application. The ePAVE program will prompt the filer to associate an IDS file with a new application file and to provide payment information, where either is appropriate. As with the other five types of electronic submissions, ePAVE will validate the information, display it to the filer, prompt for the filer's electronic signature, use the filer's digital certificate, obtained from the USPTO Electronic Business Center, to encrypt the whole package, and transmit the submission to the USPTO. Upon receipt, the Office will send to the filer an electronic post card "Acknowledgement Receipt", itemizing a server date stamp, a unique server number (also known as the EFS ID), the application number, and confirmation of the names, types, and sizes of the files received by the USPTO. If the IDS submission is subsequent to the application filing, the filer will be required to enter both an application number and a confirmation number. A confirmation number is an additional four-digit identifier assigned to an application, and can be found in the upper left-hand corner of the official filing receipt. An IDS cannot be electronically transmitted prior to an initial filing. A filer will be required to have a customer number, obtained from the USPTO Electronic Business Center, and a USPTO provided digital certificate to use EFS as with current practice.

The IDS form submitted electronically will be printed and placed in the Office's application file wrapper. The cited document numbers will be made available electronically to the examiner to facilitate searching and retrieval of U.S. patents and U.S. application publications. It is most important that the cited patent and application publication numbers be accurate and devoid of transcription error. Because the IDS filer will not submit copies of cited documents, there will be no copies of the disclosed documents in the file wrapper for the examiner to review. Instead, the examiner will electronically retrieve the patents and application publications identified by the cited document numbers. The only mechanism for having the correct document reviewed and considered when an erroneous patent or application publication number is cited in an IDS citation will be by citing the correct citation number in a subsequent IDS that conforms to the requirements of 37 CFR 1.97 and 1.98. The IDS form will be entered as a paper into the application file indicating that it was received on the date the form was completely received via EFS. This is the date the Office will refer to in considering compliance with 37 CFR 1.97 and 1.98. Examiners will consider the U.S. patents and U.S. application publications cited on an EFS transmitted IDS form provided the remaining requirements of 37 CFR 1.97 and 1.98 are met, by reviewing electronic or printed copies produced from the Office electronic databases.

It may be necessary to file a complete IDS via multiple submissions for several reasons: (1) the foreign patent documents and non-patent literature must still be submitted in paper, where the U.S. patents and U.S. patent application publications may be submitted electronically; and (2) the electronic submission can only include up to 50 U.S. patents and U.S. patent application publications. If more than one submission is necessary to file a complete IDS for which a fee is required under 37 CFR 1.17(p), only a single fee under 37 CFR 1.17(p) will be required under the following conditions: (1) the fee required by 37 CFR 1.17(p) is included with the first electronic submission (since it will normally be processed first); (2) all subsequent submissions making up the IDS should explicitly state that the fee was included in the earlier submission and request that the one submitted fee be accepted for the second and any subsequent submission; and (3) all subsequent submissions (electronic or paper) must be received by the Office on the same date as the first electronic submission with which the fee was included. A subsequent non-electronic submission is considered received by the Office on the same date as the first electronic submission with which the fee was included for purposes of the fee due under 37 CFR 1.17(p) if it is deposited in Express Mail under 37 CFR 1.10, deposited in the first class U.S. mail with a certificate of mailing in accordance with 37 CFR 1.8, or transmitted by facsimile with a certificate of transmission in accordance with 37 CFR 1.8, on the same date as the first electronic submission with which the fee was included. If a subsequent electronic IDS submission is received by the Office on a date later than the date the fee was paid, the later submission will require an additional fee.

FOR FURTHER INFORMATION CONTACT:

For information regarding the software, including installing and operating the software, the technical requirements and data

definitions and requirements, contact the Electronic Business Center Help Desk by telephone at (703) 305-3028 or (703) 308-6845 or by electronic mail at efs@uspto.gov. For information regarding how the electronic IDS transmittals interact with the prosecution process, including legal and regulatory requirements, contact Anton Fetting in the Office of Patent Legal Administration by telephone at (703) 305-8449, by facsimile at (703) 746-3312, or by electronic mail at anton.fetting@uspto.gov.

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